

## REMARKS

This is a full and timely response to the final Office mailed December 1, 2004 (Paper No./Mail Date 041016). Reconsideration and allowance of the Application and present claims are respectfully requested. Applicants should not be presumed to agree with any statements made by Examiner regarding the rejections and objections made in the Office Action unless otherwise specifically indicated by Applicants.

### I. Election/Restrictions

Claims 87-95 and 100-108 are canceled without prejudice, waiver, or disclaimer. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present Application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

### II. Priority

Applicants are not addressing the validity of all assertions made in the Office Action regarding the priority of this Application. Therefore, Applicants should be not presumed to agree with any statements made in the Office Action regarding the priority of the Application unless otherwise specifically indicated by Applicants.

### III. Response To Claim Rejections Under 35 U.S.C. §102

Claims 83-86 and 96-99 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2004/0117831 to *Ellis, et al.* Applicants respectfully traverse this rejection for the reasons that follow.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

A. Claim 83

Claim 83, as amended, recites:

83. A method implemented by a television set-top terminal (“STT”) comprising the steps of:

providing a list of rentable video presentations by their respective titles;

receiving a first viewer input configured to select one of the rentable video presentations from the list of video presentations, the selected rentable video presentation having a release date for rentability in the future;

associating the selected rentable video presentation with a reminder list responsive to receiving the first viewer input; and

*responsive to associating the selected video presentation with the reminder list,*

*providing the future release date of the selected rentable video presentation responsive to receiving a second viewer input selecting the selected rentable video presentation from the reminder list, and*

*providing reminder information to the viewer after the rentability of the selected rentable video presentation becomes effective, wherein the provided reminder information is different than a reminder corresponding to the start time of a video presentation.*

(Emphasis Added)

The Office Action admits that “*Ellis et al.* is unclear as to the particular association and generation of a ‘reminder list’ in connection with the unavailable programming as the illustrated example of a ‘reminder list’ is illustrated in connection with a personalized schedule of programs (Figure 20; [Para. 150-151]). Rather, such details are more clearly set forth and illustrated in the *McKissick et al.* application expressly incorporated by reference [Para. 134].”

- i. *Ellis and McKissick fail to disclose “responsive to associating the selected video presentation with the reminder list, providing the future release date of the selected rentable video presentation responsive to receiving a second viewer input selecting the selected rentable video presentation from the reminder list,” as recited in claim 83.*

In fact, *Ellis* discloses the following:

“[0133] FIG. 11 shows an example of the Movies Coming Soon screen that may be displayed if the user selects Coming Soon option 132D from Movies screen 130. This screen shows list 192 of movies that are not currently scheduled in the time frame supported by the guide, but which

will be available on Television in the future. List 192 may include options such as a movie that is currently in theatrical release, and which will be available on-demand or on pay-per-view in the next few weeks, a movie that may be available on cable channel, and a movie that will be available on broadcast networks. List 192 may also include a made-for-cable movie and a made-for-Television movie. The listings of movies or categories of movies coming soon may be maintained on a server at the television distribution facility or at database 14 and available on request by the program guide at set-top box 26.

[0134] The user may select a movie in listing 192 to view a Program Information screen for that movie which allows the user to view information related to the movie or find local theatrical showings. The Program Information screen may show the projected availability date and/or channel of the movie. The Program Information screen also allows the user to request a notification when the selected movie becomes available within the guide. Further features of an illustrative electronic program guide with advance notification is described in McKissick et al. U.S. patent application Ser. No. 09/378,533, filed Aug. 20, 1999, which is hereby incorporated by reference herein in its entirety.”

(Emphasis Added)

*Ellis* appears to disclose a ”Coming Soon” screen 192, which an *Ellis* Program Information screen may show when a user selects a showing from the *Ellis* screen 192. The *Ellis* Program Information screen provides the projected availability date and allows the user to request a notification when the selected movie becomes available within the guide. However, because *Ellis* does not disclose a reminder list as admitted in the Office Action, *Ellis* does not provide the projected availability date of showings from a reminder list.

Applicants respectfully submit that *McKissick* simply does not disclose or teach “responsive to associating the selected video presentation with the reminder list, providing the future release date of the selected rentable video presentation responsive to receiving a second viewer input selecting the selected rentable video presentation from the reminder list”, (Emphasis Added) as recited in claim 83. Accordingly, a prima facie case of anticipation cannot be established based on *Ellis* and *McKissick*. Applicants respectfully request that claim 83 be allowed and the rejection be withdrawn.

- ii. *Ellis and McKissick fail to disclose “responsive to associating the selected video presentation with the reminder list, ... providing reminder information to the viewer after the rentability of the selected rentable video presentation becomes effective, wherein the provided reminder information is different than a reminder corresponding to the start time of a video presentation,” as recited in claim 83.*

As mentioned above, because *Ellis* does not disclose a reminder list as admitted in the Office Action, *Ellis* does not disclose or teach “responsive to associating the selected video presentation with the reminder list, ... providing reminder information to the viewer after the rentability of the selected rentable video presentation becomes effective, wherein the provided reminder information is different than a reminder corresponding to the start time of a video presentation,” (Emphasis Added) as recited in claim 83.

*McKissick* appears to disclose a notification list but no reminder list. Further, there is a distinction between notification and reminder as described in *McKissick* on page 16, lines 27-30, which states, “For programs that are already in the current time frame of a program guide, a notification cannot be available, although a reminder option can be available.” Applicants respectfully submit that *McKissick* does not disclose or teach “responsive to associating the selected video presentation with the reminder list, ... providing reminder information to the viewer after the rentability of the selected rentable video presentation becomes effective, wherein the provided reminder information is different than a reminder corresponding to the start time of a video presentation,” (Emphasis Added) as recited in claim 83. Accordingly, a prima facie case of anticipation cannot be established based on *Ellis* and *McKissick*. Applicants respectfully request that claim 83 be allowed and the rejection be withdrawn.

B. Claim 96

Claim 96, as amended, recites:

96. A television set-top terminal (“STT”) comprising:  
memory configured to store program code; and  
a processor programmed by the program code to enable the STT  
to, associate a selected rentable video presentation rentable via the STT  
with a reminder list responsive to receiving a first viewer input, the  
selected rentable video presentation having a release date for rentability in  
the future;

***while the release date is in the future provide the release date for rentability of the selected rentable video presentation responsive to receiving a second viewer input selecting the selected rentable video presentation from the reminder list; and***

***provide reminder information to the viewer after the rentability of the selected rentable video presentation becomes effective, wherein the provided reminder information is different than a reminder corresponding to the start time of a video presentation.***

(Emphasis Added)

- i. Ellis and McKissick fail to disclose “while the release date is in the future provide the release date for rentability of the selected rentable video presentation responsive to receiving a second viewer input selecting the selected rentable video presentation from the reminder list,” as recited in claim 96.

As mentioned above with reference to claim 83, because *Ellis* does not disclose a reminder list as admitted in the Office Action, *Ellis* does not disclose or teach “while the release date is in the future provide the release date for rentability of the selected rentable video presentation responsive to receiving a second viewer input selecting the selected rentable video presentation from the reminder list,” (Emphasis Added) as recited in claim 96.

In addition, *McKissick* simply does not disclose or teach “while the release date is in the future provide the release date for rentability of the selected rentable video presentation responsive to receiving a second viewer input selecting the selected rentable video presentation from the reminder list,” as recited in claim 96. Accordingly, a prima facie case of anticipation cannot be established based on *Ellis* and *McKissick*. Applicants respectfully request that claim 96 be allowed and the rejection be withdrawn.

- ii. Ellis and McKissick fail to disclose “provide reminder information to the viewer after the rentability of the selected rentable video presentation becomes effective, wherein the provided reminder information is different than a reminder corresponding to the start time of a video presentation,” as recited in claim 96.

As mentioned above, because *Ellis* does not disclose a reminder list as admitted in the Office Action, *Ellis* does not provide the projected availability date of showings from a reminder list. In addition, *McKissick* appears to disclose a notification list but no reminder list. Further, there is a distinction between notification and reminder as described in *McKissick* on page 16, lines 27-30, which states, “For programs that are already in the current time frame of a program guide, a notification cannot be available, although a reminder option can be available.” Applicants respectfully submit that *Ellis* and *McKissick* do not disclose or teach “provide

reminder information to the viewer after the rentability of the selected rentable video presentation becomes effective, wherein the provided reminder information is different than a reminder corresponding to the start time of a video presentation,” (Emphasis Added) as recited in claim 96. Accordingly, a prima facie case of anticipation cannot be established based on *Ellis* and *McKissick*. Applicants respectfully request that claim 96 be allowed and the rejection be withdrawn.

C. Claims 84-86 and 97-99

Because independent claims 83 and 96 are allowable over the cited art of record, dependent claims 84-86 and 97-99 are allowable as a matter of law for at least the reason that dependent claims 84-86 and 97-99 contain all features and elements of their respective independent base claims. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Accordingly, the rejection to dependent claims 84-86 and 97-99 should be withdrawn for at least this reason, among others.

IV. Newly Added Claims

Claims 109-113 have been newly added. The newly added claims 109-113 are adequately supported by the specification. Consideration of new claims 109-113 is respectfully requested. The references cited in the Office Action do not disclose, teach, or suggest any of the newly added claims 109-113.

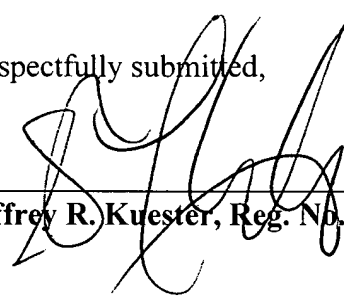
Because independent claim 83 is allowable over the cited art of record, dependent claims 109-111 are allowable as a matter of law for at least the reason that dependent claims 109-111 contain all features and elements of their respective independent base claims. See *In re Fine*, supra. Accordingly, the rejection to dependent claims 109-111 should be withdrawn for at least this reason, among others.

Claims 112-113 are allowable for at least the reason that none of the cited references teach, suggest, or disclose “responsive to associating the selected video presentation with the second portion of the reminder list, providing a selectable option to select the first or the second portion of rentable video presentations from the reminder list, and providing reminder information to the viewer after the selected rentable video presentation becomes available for rent via the STT, the reminder information being configured to remind the viewer that the selected rentable video presentation has become available for rent via the STT.”

### CONCLUSION

Applicants respectfully maintain that the currently pending claims 83-86, 96-99 and 109-113 are in condition for allowance. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, he is respectfully requested to telephone the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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